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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,554	08/22/2000	Richard Alan Fiedotin	61018-0008-US	9688
24341	7590	12/23/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			GILLIGAN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/643,554	<b>Applicant(s)</b> FIEDOTIN ET AL.	
	<b>Examiner</b> Luke Gilligan	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. In the amendment filed 9/20/05, the following has occurred: claims 1, 22, and 24 have been amended and claims 31-35 have been added. Now, claims 1 and 3-35 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-7, 11, 15, 16, 18, 20, 21, and 26-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Halvorson, U.S. Patent No. 4,847,764.

4. As per claim 1, Halvorson teaches a method for renewing a prescription for a pharmaceutical via an electronic network, comprising the steps of: computing monitoring an expiration date of a prescription by periodically determining whether a predetermined time period before said expiration date has been reached (see column 5, lines 27-29); computing generating a prescription renewal request for the renewal of said prescription prior to said expiration date based on said computer monitoring, wherein said generating occurs without human intervention (see column 5, lines 29-32 the Examiner considers informing each physician of orders that require renewal to be generation of a prescription renewal request); transmitting said prescription renewal request to a prescriber (see column 5, lines 29-32); receiving a renewal prescription, in response to said prescription renewal request, from said prescriber (see column 4, lines 28-32 and column 10, line 40, note that all prescriptions must be authorized by a physician); and notifying a dispenser to fill said renewal prescription (see column 4, lines 28-32).

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5. As per claim 3, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches creating said prescription renewal request from the following: a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (see column 10, lines 1-43).

6. As per claim 4, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches prior to said receiving step, providing information useful to said prescriber for reviewing said prescription renewal request (see column 4, lines 43-55).

7. As per claim 5, Halvorson teaches the method of claim 4 as described above.

Halvorson further teaches said information is selected from the following: warnings for any drug-drug reactions, formulary listings, patient medication history, and low cost therapeutic alternatives (see column 4, lines 43-55).

8. As per claim 6, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches said receiving step further comprises the step of acquiring a renewal prescription, wherein said renewal prescription has components that have been changed from said prior prescription (see column 16, lines 51-63).

9. As per claim 7, Halvorson teaches the method of claim 6 as described above.

Halvorson further teaches said components are selected from the following a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (see column 10, lines 1-43).

10. As per claim 11, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches the steps of claim 1 occur for a plurality of prescription renewal requests and renewal prescriptions (see column 14, lines 55-65).

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11. As per claim 15, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches deleting said prescription renewal request after a set time (see column 15, lines 16-28).

12. As per claim 16, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches deleting said renewal prescription after a set time (see column 15, lines 16-28).

13. As per claim 18, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches determining whether a prescribed pharmaceutical from said prior prescription is on formulary (see column 8, line 24); and dispensing said prescribed pharmaceutical based on said determining step (see column 8, line 25).

14. As per claim 20, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches the initial step of determining whether refills are available for said prior prescription (see column 23, lines 26-31).

15. As per claim 21, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches obtaining a patient record, said obtaining a patient record, said record containing at least a patient identifier, a pharmaceutical identifier for a currently prescribed pharmaceutical, a number of authorized refills of the currently prescribed pharmaceutical, and a date of the last filling of the currently prescribed pharmaceutical (see column 10, lines 1-30); and setting a renewal date before a last refill has been consumed by a patient if said number of authorized refills is greater or equal to a predetermined number (see column 14, lines 58-65).

16. As per claim 26, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches determining when a prescribed refill will expire (see column 5, lines 27-32); setting a renewal date prior to expiration of said prescribed refill (see column 14, line

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44); and periodically determining whether said renewal date has been reached (see column 5, lines 27-32).

17. As per claim 27, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches said prescription comprises multiple prescriptions for a patient (see column 4, lines 47-52).

18. As per claim 28, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches said prescription comprises multiple prescriptions for multiple patients (see column 4, lines 47-52).

19. As per claim 29, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches said prescription comprises a prescription for multiple patients (see column 4, lines 56-59).

20. As per claim 30, Halvorson teaches the method of claim 1 as described above.

Halvorson further teaches said computer monitoring occurs without patient intervention (see column 5, lines 27-32).

21. Claims 31-35 recite substantially similar limitations to those already addressed in claims 1 and 3-6 with the exception that the claims do not require any computer involvement, nor are there any limitations specifying who or what generates a prescription renewal request.

Therefore, since claims 31-35 are merely broader versions of claims 1 and 3-6, they are rejected for similar reasons as given above.

### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 8-10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halvorson, U.S. Patent No. 4,847,764 in view of Mayaud, U.S. Patent No. 5,845,255.

24. As per claim 8, Halvorson teaches the method of claim 1 as described above. Halvorson does not explicitly teach acquiring an appeal from a patient to contact said prescriber. Mayaud teaches acquiring an appeal from said prescriber for a patient of said prior prescription to contact said prescriber (see column 23, lines 29-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Halvorson. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of communicating emergency information to a patient to enhance the safety of the patient (see column 23, lines 30-32).

25. As per claim 9, Halvorson in view of Mayaud teach the method of claim 8 as described above. Halvorson does not explicitly teach notifying said dispenser to inform said patient to contact said prescriber. Mayaud further teaches said acquiring step further comprises notifying said dispenser to inform said patient to contact said prescriber (column 23, lines 29-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Halvorson for the reasons given above with respect to claim 8.

26. As per claim 10, Halvorson in view of Mayaud teach the method of claim 8 as described above. Halvorson does not explicitly teach notifying said patient to contact said prescriber. Mayaud further teaches said acquiring step further comprises notifying said patient to contact said prescriber (see column 23, lines 29-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Halvorson for the reasons given above with respect to claim 8.

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27. As per claim 19, Halvorson teaches the method of claim 18 as described above.

Halvorson does not explicitly teach ascertaining whether said prescribed pharmaceutical is a chronic medication and storing the result. Mayaud teaches ascertaining whether said prescribed pharmaceutical is a chronic medication (see column 20, lines 41-49 and Figure 3, the patient history would indicate if a prescription had been prescribed for a chronic illness); and storing a result of said ascertaining step (see column 20, lines 41-49 and Figure 3, this result is at least temporarily stored in the memory of the portable computing device). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing the automatic inventory control aspect of Halvorson by accounting for medications that will need to be utilized on a recurring basis for chronically ill patients (see 5, lines 43-50 of Halvorson).

28. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halvorson, U.S. Patent No. 4,847,764 in view of **nevoca.com Enhances Prescription Verification System** (hereinafter nevoca).

29. As per claim 12, Halvorson teaches the method of claim 1 as described above.

Halvorson does not explicitly teach ascertaining a status of said prescription renewal request. Nevoca teaches ascertaining a status of said prescription renewal request (see paragraph 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Halvorson. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).



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30. As per claim 13, Halvorson in view of nevoca teach the method of claim 12 as described above. Halvorson does not explicitly teach determining how many prescription renewal requests were transmitted to said prescriber and establishing how many prescription renewal requests said prescriber has addressed. Nevoca teaches these determining and establishing steps (see paragraph 9, the Examiner asserts that these steps would be necessary to determining the "exact status" when a doctor has not yet responded to a prescription renewal request). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Halvorson for the reasons given above with respect to claim 12.

31. As per claim 14, Halvorson in view of nevoca teach the method of claim 12 as described above. Halvorson does not explicitly teach sending the status to said prescriber. Nevoca teaches said ascertaining step further comprises the step of sending said status to said prescriber (see paragraphs 4 and 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to incorporate this feature into the system of Halvorson for the reasons given above with respect to claim 12.

32. Claims 17 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halvorson, U.S. Patent No. 4,847,764 in view of **Biomerica and Viking Components Announce Strategic Partnership for Final Phase of ReadyScript** (hereinafter ReadyScript).

33. As per claim 17, Halvorson teaches the method of claim 1 as described above. Halvorson further teaches accepting said prescription renewal request (see column 5, lines 27-32); displaying said prescription renewal request to said prescriber (see column 5, lines 27-32); showing said prescriber information useful for reviewing said prescription renewal request (see column 4, lines 47-55); and communicating said renewal request (see column 4, lines 28-33).

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Halvorson does not explicitly teach a server and a portable computing device for communicating the various steps. ReadyScript discloses communicating prescription information from a web server to a portable computing device that is used by a prescriber (see paragraph 2), where such communication is used to automate the prescription renewal process between prescribers and dispensers (see paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a system architecture into the system of Halvorson. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhancing the convenience for patients of not having to wait for prescriptions to be filled by providing additional automation and technology in implementing the prescription renewal process of Halvorson (see paragraph 9).

34. Claims 22 and 23 contain substantially similar limitations to claims 1, 5 and 17 and, as such, are rejected for similar reasons as given above.

35. Claims 24 and 25 contain substantially similar limitations to claims 1 and 17 and, as such, are rejected for similar reasons as given above.

#### ***Response to Arguments***

36. In the remarks filed 9/20/05, Applicant argues in substance that prior art of record fails to teach certain features of the claims as now amended. In response to Applicant's arguments, the Examiner agrees the changes made by Applicant to the claims has overcome the previous grounds of rejection. However, the Examiner has now applied a new grounds of rejection in view of new prior art (Halvorson in particular). Therefore, it is respectfully submitted that these arguments are now moot in view of the new grounds of rejection as detailed above.

***Conclusion***

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Brinkman teaches a system that automatically generates prescription renewal reminders for a population of patients.
- Drug Store News discloses electronic prescription renewal and automatic prescription renewal notification.
- Business Wire article discloses automatic prescription renewal as offered by Alteer Corp.
- Parks discloses Rx services offered by WebMD that automates prescription renewal requests and prescription renewal authorization.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**C. Luke Gilligan**  
**Patent Examiner**  
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